REMARKS/ARGUMENTS

I. PRIOR ART MATTERS

A. The Office Action rejected claims 27-36 under 35 USC 103(a) as being unpatentable over Kataoch in view of Schweizer. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting and *prima facie* conclusion of obviousness.[1] If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.[2]

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation or success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.[3]

The fact that a prior art device could be modified to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification.[4] Both the suggestion and the expectation of the success must be founded in the prior art, not in the applicant's disclosure.[5] When obviousness is based on a single reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.[6]

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[1] MPEP Sec. 2142.
[2] Id.
[3] Id. (emphasis supplied)
[4] *In re Gordon,* 733 F.2d 900 (Fed. Cir. 1984)
[5] *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988)
[6] In re Kotzab, 208 F.3d 1352 (Fed. Cir. 2000)

There is no suggestion to combine if a reference teaches away from its combination with another source. A reference may be said to teach away a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant.[7]

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The cited references do not teach or suggest all the claim limitations.

As to amended claim 27, the cited references do not teach the apparatus wherein the stacking mechanism further comprises a plurality of moving stacker shelves, wherein the receiving mechanism further comprises a conveyor moving in the direction of motion of the moving stacker shelves and tracking the motion of the moving stacker shelves, and wherein the buffering mechanism further comprises the plurality of moving stacker shelves and the conveyor tracking the motion of the moving stacker shelves.

Specifically, the conveyor 17 of Katoch does not move in the direction of motion of the moving stacker shelves and track the motion of the moving stacker shelves. Rather, the conveyor 17 of Katoch is stationary relative to the direction of motion of the moving stacker shelves.

Claim 27 is therefore allowable.

Claim 28-30 are cancelled.

Claim 31-32 contain additional elements or limitations beyond allowable claim 27 and are also available.

New claim 33 is also allowable over the cited prior art. No new matter is introduced in the claim, but rather is found in the original disclosure at page 8, lines 20-22 and in Figs. 2a and 2b.

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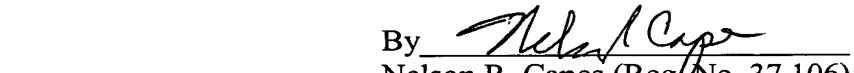
[7] *Tec Air v. Denso Mfg. Michigan, Inc.,* 192 F.3d 1353 (Fed. Cir. 1999)

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Applicant thanks the Examiner for indicating the allowable subject matter.

Respectfully submitted,

By 

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